

REMARKS

Restriction Requirement

The Office Action has set forth a restriction requirement. Specifically, the Office Action has set forth the following groups of claims:

(I) claims 75-85, drawn to a nucleic acid molecule, and

(II) claims 86-95, drawn to a method for amplifying and for detecting bacterial DNA in a sample.

The Office Action also requires an election of species. Specifically, Applicants are required to elect a single nucleic acid sequence or a single amino acid sequence, depending upon the claim election.

Applicants' Election of Claims and Species

Applicants elect, with traverse, the claims of Group II (claims 86-95), drawn to a method for amplifying and detecting bacterial DNA in a sample.

With respect to the election of species requirement, Applicants elect, with traverse, SEQ ID NO: 2 which can be used for detecting bacteria including enterobacteria. In addition, Applicants elect sequences SEQ ID NOS: 2 and 25, as a pair, to the extent the election of a pair is provided for under M.P.E.P. § 803.04.

Applicants respectfully request reconsideration of the restriction requirement and the election of species requirement.

Discussion of the Restriction Requirement and Election of Species

Since the present application is the U.S. national stage of a PCT application, the pertinent PCT articles and rules are to be consulted (see M.P.E.P. § 802). Under PCT Rule 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. PCT Rule 13.2 defines the term "special technical features" as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art (see M.P.E.P. § 1893.03(d)).

The Office Action contends that, while the claims of Groups I and II are linked by the technical feature of the nucleic acid sequences, this technical feature is not *special* because it does not constitute an advance over the prior art, particularly Brosius et al., *J. Mol. Biol.*, 148(2), 107-127 (1981). The Brosius reference, however, does not disclose the elected nucleic acid sequences. Moreover, a patentability search of the claims of Group II likely would uncover references that would be considered by the Examiner during the examination of Group I. Thus, the nature of the claims of Groups I and II is such that any burden

encountered in searching these Groups together would, at most, be slight (and certainly not “serious”). Accordingly, Applicants request the withdrawal of the restriction requirement.

With regard to the election of species, Applicants elect, with traverse, SEQ ID NO: 2. However, Applicants note that, under M.P.E.P. § 803.04, as explained by Examiner Kenneth R. Horlick in Applicants’ telephonic interview of November 1, 2004, Applicants may elect a primer pair of nucleic acid sequences. In which case, Applicants elect, with traverse, SEQ ID NOS: 2 and 25, as a pair.

Applicants also request the examination of SEQ ID NOS: 3, 5, 7, 13, 15, 21, 23, and 24. In this respect, M.P.E.P. § 803.04 provides that up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction (see M.P.E.P. § 803.04). SEQ ID NOS: 2, 3, 7, 13, 15, and 21 are homologous to one another and to SEQ ID NO: 2. Similarly, SEQ ID NOS: 23 and 24 are homologous to one another and to sequence SEQ ID NO: 25. Moreover, all of these sequences can be used as primer pairs and probes for the amplification and detection of bacteria, particularly enterobacteria. As such, all of these sequences encompass the same conserved region encompassing portions of the 23S rRNA and 5S rRNA genes and the transcribed spacer in between these rRNA genes common to all enterobacteria. Indeed, the nature of these sequences is such that any burden encountered in searching these sequences together would, at most, be slight (and certainly not “serious”), which dictates the consideration of these sequence at the same time (see M.P.E.P. § 803). Therefore, the election of species requirement should be withdrawn so as to allow the examination of at least SEQ ID NOS: 3, 5, 7, 13, 15, 21, 23, 24, and 25 together with SEQ ID NOs: 2.

Applicants note that, upon allowance of claims containing the elected sequences, any non-elected claims encompassing those sequences should be rejoined and considered with respect to the allowed sequences.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

In re Appln. of Grabowski et al.
Application No. 10/088,966

Respectfully submitted,



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Date: March 21, 2005